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PTO/SB/21 (02-04)  
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Total Number of Pages in This Submission

35

Application Number

09/694,136

Filing Date

10/23/2000

First Named Inventor

Herbert M. Straub

Art Unit

1774

Examiner Name

Lawrence D. Ferguson

Attorney Docket Number

20003

### ENCLOSURES (Check all that apply)



Fee Transmittal Form



Fee Attached



Amendment/Reply



After Final



Affidavits/declaration(s)



Extension of Time Request



Express Abandonment Request



Information Disclosure Statement



Certified Copy of Priority Document(s)



Response to Missing Parts/  
Incomplete Application



Response to Missing Parts  
under 37 CFR 1.52 or 1.53



Drawing(s)



Licensing-related Papers



Petition



Petition to Convert to a  
Provisional Application



Power of Attorney, Revocation



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CD, Number of CD(s) \_\_\_\_\_



After Allowance communication  
to Technology Center (TC)



Appeal Communication to Board  
of Appeals and Interferences



Appeal Communication to TC  
(Appeal Notice, Brief, Reply Brief)



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Status Letter



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Richard L. Marsh

Signature

Date

26 July 2004

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# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ ) 165.00

**Complete if Known**

Application Number	09/694,136
Filing Date	23 October 2000
First Named Inventor	Herbert M. Straub
Examiner Name	Lawrence D. Ferguson
Art Unit	1774
Attorney Docket No.	20003

**METHOD OF PAYMENT** (check all that apply)
☐ Check ☒ Credit card ☐ Money Order ☐ Other ☐ None
☐ Deposit Account:
 Deposit  
Account  
Number  
Deposit  
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Name


The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments☐ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, **except for the filing fee** to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$ )

**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

		Extra Claims		Fee from below		Fee Paid	
Total Claims		-20** =		X		=	
Independent Claims		-3** =		X		=	
Multiple Dependent						=	

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	18	2202	9	Claims in excess of 20	
1201	86	2201	43	Independent claims in excess of 3	
1203	290	2203	145	Multiple dependent claim, if not paid	
1204	86	2204	43	** Reissue independent claims over original patent	
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent	

SUBTOTAL (2) (\$ )

\*\*or number previously paid, if greater; For Reissues, see above

**FEE CALCULATION** (continued)**3. ADDITIONAL FEES**

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	165.00
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) \_\_\_\_\_

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ ) 165.00

**SUBMITTED BY**

Name (Print/Type)	Richard L. Marsh	Registration No. (Attorney/Agent)	31,637	Telephone	417/887-8441
Signature		Date	26 July 2004		

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :  
Straub, et al. : Group Art Unit # 1774  
Serial No. 09/694,136 : Examiner: Lawrence D. Ferguson  
Filed: 23 October 2000 : Date: 26 July 2004  
RCE filed: 21 February 2003 :  
:  
For: DECORATIVE MOLDING, :  
DECORATIVE OVERLAYS AND :  
FILMS THEREFOR AND METHODS :  
AND APPARATUS FOR MAKING :  
THE SAME :

The Honorable Commissioner of Patents and Trademarks  
Mail Stop Appeal Brief- Patents  
Washington, D.C. 20231

APPELLANTS' APPEAL BRIEF

Sir:

Pursuant to 37 CFR 1.193, Appellants hereby file an Appeal Brief in the above-identified application Serial Number 09/694,136 as follows.

REAL PARTY IN INTEREST:

Herbert M. Straub, Martin D. Straub and Timothy D. Ryan, Joint Inventors.

RELATED APPEALS AND INTERFERENCES:

There are no Appeals or Interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this pending Appeal. The Appellants' legal representative is the undersigned registered Agent of Record.

STATUS OF CLAIMS:

Claims 1 - 15, 17 - 18 and 20 are pending in this application and are appealed for decision before the Board, claims 1 - 15, 17 - 18 and 20 having been finally rejected in the Office action dated 05 March 2004. Claims 16 and 19 were previously canceled.

#### STATUS OF AMENDMENTS:

In response to the Final Rejection of 05 March 2004, an amendment after final rejection was transmitted by telefax on 14 April 2004 to the Examiner with a certificate of mailing/transmission in an attempt to further clarify the structure of the product claimed in the invention and to reduce or remove issues for appeal. The Examiner did not enter the Amendment After Final response of 14 April 2004 into the record and an Advisory Action was mailed by the Examiner on 11 May 2004 so stating. It is noted in the Advisory Action that the amended claims would "raise new issues that would require further consideration and/or search," however, Appellants note that the Examiner has already conducted at least two prior art searches in the broader field of stock materials and methods which would have also revealed narrower stock materials and methods, all of which would have been considered in the prior office actions. Appellants are thus at a loss as to why narrowing of the claims would require further search and consideration as all the applicable art should have already been found and considered by the Examiner.

#### SUMMARY OF THE INVENTION:

As stated in thrice amended independent claim 1 in the appealed office action, generally in original claim 1 of the specification, first appearing in the specification on page 5, lines 26 through page 6 line 3 and again on page 6, lines 4 - 8, thereafter fully described in the specification beginning on line 15 of page 11 continuing into line 6 of page 14 and shown in drawing Figures 1, 2 and 3, the present invention clearly provide for a paper decorative wrapping film comprising **at least one** hot transfer inked foil carried on a carrier having the hot transfer inked foil **laminated** onto a planar wrapping paper thereby marrying the hot transfer foil to the planar wrapping paper, the marrying of the hot transfer inked foil to the planar wrapping paper thus creating the novel paper decorative wrapping film wherein the carrier is removed from the hot transfer foil now married to the paper decorative wrapping film, the paper decorative wrapping film subsequently wound upon a roll for use in wrapping of a substrate. In addition, Appellants have clearly shown that claim 1 is patentable over the prior art as none of the prior art shows a hot transfer ink layer transferred from a roll of hot transfer ink onto a previously decorated wrapping film

whereafter the carrier upon which the hot transfer ink was disposed is stripped away from hot transfer ink leaving the novel wrapping film having at least two layers of decoration thereupon. (Emphasis added)

As further provided in thrice amended claim 2, original claim 2 of the specification, as first noted in the specification on page 6 beginning in line 22 continuing through line 1 of page 7, shown in Figure 5 and fully described in the specification on page 14 beginning in line 6 continuing through page 14 at line 17, at least **one other** hot transfer foil is layered upon the novel paper decorative wrapping film of claim 1 thereby marrying the other hot transfer foil to the paper decorative wrapping film of claim 1. In addition to being clearly stated, claim 2 has also been shown to be separately patentable over the art because none of the prior art describes a hot transfer ink layer transferred from a roll of hot transfer ink onto a previously decorated wrapping film whereafter the carrier upon which the hot transfer ink was disposed is stripped away from hot transfer ink and wherein another hot transfer ink layer is transferred from another roll of hot transfer ink onto the hot transfer ink applied to the previously decorated wrapping film in claim 1 whereafter the carrier upon which the another hot transfer ink was disposed is stripped away from the another hot transfer ink leaving the novel wrapping film having at least three layers of decoration thereupon. Accordingly, claim 2 stands with claim 1 as clearly patentable over the prior art. (Emphasis added)

Additionally, as first noted in the specification on page 6 beginning on line 22 continuing through line 1 of page 7, in thrice amended claim 3, in original claim 3 of the specification and as described in the specification specifically on page 14 in line 27 - 29, an adhesive is applied to the side of the novel paper decorative wrapping film of claim 2 opposite the laminated layers of applied decoration wherein the novel paper decorative wrapping film of claim 2 is adapted to be wrapped about a substrate. Though it is known, and already admitted by Appellants, to apply an adhesive to a wrapping film, it is not known to first provide the wrapping film of claim 1 having at least one hot transfer ink layer transferred from a roll of hot transfer ink onto a previously decorated wrapping film whereafter the carrier upon which the hot transfer ink was disposed is stripped away from

hot transfer ink and thereafter apply another hot transfer ink layer as provided in claim 2 upon the hot transfer layer applied in claim 1 leaving the novel wrapping film having at least three layers of decoration thereupon and thereafter applying an adhesive thereto. Therefore, claim 3 is clearly stated and is additionally separately patentable along with claims 1 and 2 over the prior art as it is fully within the statutes to further restrict an independent claim.

Furthermore, in thrice amended claim 4, in original claim 4 of the specification, as first appearing in the specification on page 5 in line 29 and fully described thereafter on page 16 in line 25 - 28, it is clearly stated that an adhesive is applied to side of the novel paper decorative wrapping film of claim 1 opposite the side having the hot transfer applied thereto, wherein the novel paper decorative wrapping film of claim 1 is subsequently intended to be wrapped about a substrate. As provided in the statutes, it is within Appellants rights to further restrict independent claim 1 by providing an adhesive to the side opposite the at least two layer decorative surface provided in claim 1, especially in view of the absence in the prior art of the material of claim 1 and therefore, claim 4 stands separately patentable with claim 1.

It is very clear that in thrice amended dependent claim 5 that the **one** hot transfer inked foil of claim 1 is a **translucent** hot transfer foil, the description thereof also first appearing in the specification on page 6, line 23, in original claim 5 and more fully described in the specification beginning on line 4 of page 12 and again in lines 2 - 8 of page 17. Though translucent inks are known in the art, application of a translucent hot transfer ink to an already decorated surface as provide in claim 1 is not described in the art and thus it is fully within the statutes to further restrict claim 1 to by stating that the hot transfer ink is translucent. Therefore, claim 5 is patentable with claim 1. (Emphasis added)

Likewise, thrice amended claim 6 recites that the **one** hot transfer inked foil married to the planar paper of claim 1 is an **opaque** hot transfer foil, the recitations also appearing in the specification in lines 2 - 8 on page 17 and again in line 23 as well as original claim 6. As with claim 5, opaque hot transfer inks are known in the industry, however, the prior art cited does not show, suggest, claim, discuss or imply that it is

obvious to hot transfer an opaque hot transfer ink onto an already decorated surface, strip away the carrier from the hot transfer ink and roll the newly decorated wrapping film upon a roll for subsequent use and thus claim 6 is abundantly clear and is also separately patentable with claim 1. (Emphasis added)

In a similar manner, thrice amended claim 7 plainly recites that the **one** hot transfer inked foil of claim 2 is an **opaque** hot transfer foil and thrice amended claim 8 distinctly recites that **the other** hot transfer inked foil is a **translucent** hot transfer foil, the description thereof also first appearing in the specification on page 6, beginning on line 22 continuing through line 1 of page 7, more fully described in the specification on page 12 in lines 4 - 8 and again on page 17 beginning on line 2 continuing into line 13 and recited in original claims 7 and 8. As has already been discussed, it is not known, nor is it obvious, to hot transfer an opaque hot transfer ink onto an already decorated surface, strip away the carrier from the opaque hot transfer ink and roll the newly decorated wrapping film upon a roll, nor to hot transfer a translucent hot transfer ink onto an already decorated surface, strip away the carrier from the translucent hot transfer inks and roll the newly decorated wrapping film upon a roll for subsequent use and therefore, it cannot also be obvious to provide the combination thereof so claim 7 is patentable with claims 1 and 2 and claim 8 is additionally patentable with claims 1, 2 and 7. (Emphasis added)

Similarly, thrice amended claim 9 unequivocally recites that the **one** hot transfer inked foil in claim 2 is a **translucent** hot transfer foil and thrice amended claim 10 specifically recites that **the other** hot transfer inked foil is a **translucent** hot transfer foil, this description first appearing in the specification on page 6, beginning on line 22 continuing through line 1 of page 7, more fully described in the specification on page 12 in lines 4 - 8 and again on page 17 beginning on line 2 continuing into line 13 and recited in original claim 9 and 10. In the same manner as it is not obvious to first transfer an opaque hot transfer ink to an already decorated surface, strip the carrier from the opaque hot transfer ink, it cannot be obvious to provide a translucent hot transfer ink onto an already decorated surface and thus claim 9 stands patentable with claims 1 and 2. Likewise, it is clear to those who practice and are skilled in the art that it is not obvious to first transfer an

opaque hot transfer ink to an already decorated surface, strip the carrier and thereafter hot transfer a translucent hot transfer ink onto an already decorated surface, it is also not obvious to first hot transfer a translucent hot transfer foil to an already decorated surface and thereafter apply at least a second translucent hot transfer foil to the first translucent hot transfer ink previously applied to the already decorated surface and therefore claim 10 is patentable along with claims 1, 2 and 9. (Emphasis added)

Clearly presented thrice amended independent claim 11 parallels independent claim 1 however, as described in the specification on lines 2 - 7 of page 7, shown in Fig. 3, claimed in original claim 11 and fully described in the specification on page 16 in lines 25 - 28, independent claim 11 claims an **embossed** wrapping paper as opposed to a planar wrapping paper wherein the embossed wrapping paper has at least **one** hot transfer foil married to the embossed wrapping paper wherein the marrying of the hot transfer foil to the embossed wrapping paper creates a laminated embossed wrapping paper, the carrier removed from the hot transfer foil now married to the laminated embossed wrapping paper with the novel embossed laminated wrapping paper wound upon a roll for later use in wrapping of a substrate. Since the embossed wrapping paper of the instant claim 11 has raised and depressed portions, hot transfer of the ink of the hot transfer foil will be applied primarily to the raised portions of the embossed paper and therefore the transforming effect upon the embossed paper is quite different from the effect found on the planar paper of claim 1. Therefore, Appellants have clearly shown that claim 11 is also patentable over the prior art as none of the prior art shows a hot transfer ink layer transferred from a roll of hot transfer ink onto an embossed wrapping film whereafter the carrier upon which the hot transfer ink was disposed is stripped away from hot transfer ink leaving the novel embossed wrapping film having at least one layer of hot transfer ink upon at least a portion of the underlying embossed wrapping film. (Emphasis added)

Pursuant to thrice amended claim 12, the **laminated embossed** wrapping paper of claim 11 is further enhanced by **marrying** at least **one other** hot transfer foil to the completed embossed laminated wrapping paper of claim 11 thus creating a embossed wrapping paper having at **least two** hot transfer foils **married** thereto wherein the matter



contained herein was also claimed in original claim 12, first appeared in the specification on page 6 in lines 22 - page 7 line 1, fully described on page 17 in lines 7 -13 and shown in Figs. 1, 2, 3 and 6. Claim 12 is therefore been shown to be separately patentable over the art because none of the prior art describes a hot transfer ink layer transferred from a roll of hot transfer ink onto an embossed wrapping film whereafter the carrier upon which the hot transfer ink was disposed is stripped away from hot transfer ink and wherein another hot transfer ink layer is transferred from another roll of hot transfer ink onto the hot transfer ink applied to the embossed wrapping film in claim 11 whereafter the carrier upon which the another hot transfer ink was disposed is stripped away from the another hot transfer ink leaving the novel embossed wrapping film with at least two layers of hot transfer ink thereupon. Accordingly, claim 12 stands with claim 11 as clearly presented and clearly patentable over the prior art.

Moreover, thrice amended claim 13 plainly recites that the embossed wrapping paper of claim 12 has an adhesive applied to a side of said laminated embossed wrapping paper opposite the other hot transfer foil, the novel laminated embossed wrapping paper now having at least more two hot transfer foils applied thereto, the novel laminated embossed wrapping paper subsequently wrapped about a substrate to be decorated this description first appearing in the specification on page 6 in line 27 and claimed in original claim 13. Though it is known, and already admitted by Appellants, to apply an adhesive to a wrapping film, it is not known to first provide the embossed wrapping film of claim 11 with at least one hot transfer ink layer transferred from a roll of hot transfer ink onto a embossed wrapping film as discussed above with respect to claim 11 and therefore, claim 13 is separately patentable along with claims 11 and 12 over the prior art as it is fully within the statutes to further restrict an independent claim and those in the chain thereof. (Emphasis added)

Like claim 13, thrice amended claim 14 clearly recites that the embossed wrapping paper of claim 11 has an adhesive applied to a side of said laminated embossed wrapping paper opposite the hot transfer foil married thereto, the novel laminated embossed wrapping paper intended to be subsequently wrapped about a substrate to be decorated the

description thereof first appearing in the specification on page 6 in line 27, fully described on page 19 in lines 6 - 9 and claimed in original claim 13. As provided in the statutes, it is within Appellants rights to further restrict independent claim 11 by providing an adhesive to the side opposite the hot transfer ink applied to the embossed decorative surface provided in claim 11, especially in view of the absence of the material of claim 11 in the prior art and therefore, claim 14 stands separately patentable with claim 11.

Thrice amended dependent claim 15 unambiguously describes that the **one** hot transfer inked foil of claim 11 is **translucent** hot transfer foil while thrice amended dependent claim 17 relates that the **one** hot transfer inked foil of claim 11 is an **opaque** hot transfer foil the descriptions thereof appearing first in the specification on page 7 in lines 2 - 7, again in the paragraph beginning on line 21 of page 7, fully described on page 12 in lines 4 - 8 and page 17 in lines 2 -3 as well as original claims 15 and 17. As with claims 5 and 6 above, translucent and opaque hot transfer inks are known in the industry, however, the prior art cited does not show, suggest, claim, discuss or imply that it is obvious to hot transfer an opaque hot transfer ink onto an embossed decorative surface, strip away the carrier from the hot transfer ink and roll the newly decorated embossed wrapping film upon a roll for subsequent use and thus claims 15 and 17 are separately patentable with claim 11. (Emphasis added)

The narration of claim 18 distinctly presents that the **one** hot transfer inked foil of claim 12 is **opaque** colored hot transfer foil as claimed in original claim 18, fully described in the specification at line 8 - 13 of page 17 and first appearing therein in lines 23 - 25 of page 8. As has already been discussed, it is not known, nor is it obvious, to hot transfer an opaque hot transfer ink onto an already decorated surface, strip away the carrier from the opaque hot transfer ink and roll the newly decorated wrapping film upon a roll, nor is it obvious to hot transfer an opaque hot transfer ink onto an embossed wrapping film and thus claim 18 is fully patentable along with claims 11 and 12 over the prior art. (Emphasis added)

As provided in patently clear claim 20, in original claim 20, noted in the specification on page 6, lines 10 - 14, described in the specification in the paragraphs

beginning on line 29 of page 21 and shown in Figs. 8 and 9, the novel paper decorative wrapping film comprises at least **one** hot transfer inked foil carried on a carrier wherein a **portion** of the ink thereon is **removed** prior to being laminated onto a planar paper wrapping film thereby creating a laminated paper wrapping film having portions of the **base color** of the planar paper wrapping film **showing therethrough** wherein the carrier is subsequently removed from the hot transfer inked foil now married to the laminated paper wrapping film. Since it has already been established that it is not obvious to hot transfer a hot transfer ink onto an already decorated surface it is also not obvious to remove a portion of the hot transfer ink from the carrier carrying the hot transfer ink prior to hot transferring the remaining hot transfer ink to the previously decorated surface. Therefore, claim 20 is fully patentable over the prior art. (Emphasis added)

ISSUES AT HAND:

Whether claims 1 - 15, 17 - 18 and 20 are indefinite under 35 U.S.C. 112, second paragraph.

The Examiner states that the phrase “a paper decorative wrapping film” is indefinite as it is unclear which is being claimed, a paper or a film. However, as will be explained fully hereinafter, it is respectfully submitted that Appellants have defined the decorative film as a paper decorative wrapping film to overcome the Examiner’s holding that the decorative wrapping material is metallic and thus have made a bona fide attempt to overcome the rejection by distinguishing between metallic films known to the Examiner and the paper decorative films used in the industry. Appellants have also respectfully requested the Examiner’s assistance in further clarifying the claims in the event that the Examiner still deemed the claims to be indefinite.

Whether claims 1 - 15, 17 - 18 and 20 are unpatentable over Kotin (U.S. 5,996,672 in view of Salgado, et al., (U.S. 6,361,839).

The Examiner states that Kotin discloses a decorative film having an embossed paper substrate that is easy to print with an adhesive applied to the back of the film. The Examiner further states that Kotin also discloses a decorative film that is laminated and that a substrate may be wrapped with a printed film where the film is flexible and can be a foil

wrap. The Examiner also states that Salgado, et al., teaches a hot stamping foil comprising a carrier where the carrier of the hot stamping foil is removable and/or the hot stamping foil may be applied to wood or paper and also states that Salgado, et al., further teaches that the foil material may be colorless or a variety of colors depending on the temperature and therefore "(I)t would have been obvious to one of ordinary skill in the art to include a colorless (translucent) or colored (opaque) hot stamping foil on the laminated decorative film of Kotin because Salgado, et al., teaches the conventionality of applying a hot stamping foil to substrates such as wood or paper which Kotin comprises, which improves the transfer of ink images onto a substrate." However, as will be explained in greater detail hereinafter, it is respectfully submitted that none of these references, nor a combination thereof, show, discuss, claim or suggest a decorative wrapping film of paper, vinyl or other material, wherein at least one hot transfer inked foil carried on a carrier has the hot transfer inked foil laminated onto a planar wrapping paper thereby marrying the hot transfer foil to the planar wrapping paper, the marrying of the hot transfer inked foil to the planar wrapping paper creating the paper decorative wrapping film wherein the carrier is removed from the hot transfer foil now married to the paper decorative wrapping film and the novel paper decorative wrapping film is wound upon a roll for use in wrapping of a substrate.

#### GROUPING OF THE CLAIMS:

The rejected claims are grouped as follows:

- a) Claim 1
- b) Claims 1 and 4 which stand or fall together;
- c) Claims 1 and 5 which stand or fall together;
- d) Claims 1 and 6 which stand or fall together;
- e) Claims 1 and 2 which stand or fall together;
- f) Claims 1, 2 and 3 which stand or fall together;
- g) Claims 1, 2 and 7 which stand or fall together;
- h) Claims 1, 2 and 7 - 8 which stand or fall together;
- i) Claims 1, 2 and 9 which stand or fall together;
- j) Claims 1, 2 and 9 - 10 which stand or fall together;

- k) Claim 11
- l) Claims 11 and 12 which stand or fall together;
- m) Claims 11 - 13 which stand or fall together;
- n) Claims 11 and 14 which stand or fall together;
- o) Claims 11 and 15 which stand or fall together;
- p) Claims 11 and 17 which stand or fall together;
- q) Claims 11, 12 and 18 which stand or fall together; and
- r) Claim 20.

ARGUMENT:

In the office action that is the subject of this appeal, the Examiner rejects all the claims remaining in this application upon 35 U.S.C. 112, second paragraph, stating that the phrase “a paper decorative wrapping film” is indefinite as it is unclear which is being claimed, a paper or a film. The term “film” is used in the field of this invention interchangeably with the term “foil” to denote a material for wrapping of a substrate whether the base material is vinyl, cellulose, another material or combination thereof. The term “foil” is also used to denote a thin layer of the ink or other material which is generally disposed upon a paper or polyacrylate carrier and removed therefrom by the well-known hot transfer method wherein the carrier generally has a release coat first applied and thereafter has the hot transfer ink foil subsequently applied thereupon. Appellants have used the term “paper decorative wrapping film” to make clear to those not skilled in the art that the decorative wrapping film is a paper substrate used as a decorative wrapping film which already having a first decorative layer thereon and thereafter, according to the teachings of the instant invention, has at least one additional decorative layer laminated to the already existing decorative layer. With regard to “paper” and “film” used to describe the inventive element in the pending claims, on page 4 of the original specification, beginning at line 27 continuing through page 5, line 8, Appellants define the terms used throughout the specification and recite that the decorative film has been produced of a cellulose paper or extruded as a rigid vinyl film that may be printed with an ink or having a pattern embossed thereon, now collectively referred to as wrapping films. Thus, it is

readily observed that the decorative wrapping film of the instant invention is initially a “paper” film as known in the industry which may or may not already have either an ink applied thereto or a pattern embossed thereupon. In the office action dated 8 May 2002, claims 1 - 10 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite as it was not clear to the Examiner if the decorative molding wrapping foil or the created laminated wrapping foil or the intermediate layer foil was being claimed. In response to Paper # 3, filed on 02 July 2002, Appellants set forth on pages 10 - 12 in Amendment A to the original application that the terms are interchangeable in the field of the invention, however, in that Amendment A, Appellants amended the claims and the specification such that the terms “film” and “foil” were consistent in an attempt to avoid confusion to those not skilled in the art, by aligning the term “film” with the usual sense of the word as a polymeric or paper sheet used to wrap around a substrate as in the definition of “vinyl wrapping films” in the definitions provided by the Laminating Materials Association and the term “foils” with the usual sense of the word to define a thin transfer product printed on a carrier and thereafter transferred to a substrate in a transfer process. Appellants believed at the time, and still believe, that the claims presented in Amendment A were clear as to language and understanding to those skilled in the art and therefore, Appellants respectfully request reconsideration and allowance of the claims presented in Amendment A of the original specification. Appellants also respectfully request re-establishing the patent term adjustment provisions of 37CFR1.702 due to the delays caused by the Office in the examination of this application as fully set forth in Appellants Petition for Recovery of Fees & Resetting of Patent Term Adjustment filed on 27 March 2003.

In the final office action to the original specification, Paper # 5, mailed on 24 September 2002, it is duly noted that the Examiner accepted the arguments made and amendments to claims 1 - 10 in Amendment A as overcoming the rejection under 35 U.S.C. 112, second paragraph, however, it became, and still is, Appellants’ belief that the Examiner views the entire disclosure containing the term “film” as comprising a rigid sheet of initially transparent material which has a solution developed thereon in selected locations, i.e., a movie film, and the term “foil” as a thin sheet of metallic material such as

household aluminum foil used to wrap foods and the like, as evidenced by the art rejections contained in Paper #3, Paper #5, Paper #8 and Paper #10, although the word “metallic” is used by Appellants in only original dependent claims 16 and 19 and once in the entire inventive disclosure in line 3 of page 17. Attention is drawn to Paper #3 mailed on 8 May 2002 and in Paper #5, the final office action mailed on 24 September 2002, a verbatim rejection of the claims, wherein the Examiner states that Suess, et al., (U.S. 5,985,078) disclose a metallic embossed foil in the abstract therefore equating the wrapping foil of the instant invention with household aluminum foils as clearly shown in the paragraph spanning pages 6 & 7 of paper No. 5. Accordingly, Appellants canceled claims 16 and 19, first in the Amendment After Final in response to the advisory action Paper #8 mailed on 10 January 2003, however, that AAF was not entered of record as evidenced in Paper #10 mailed on 12 February 2003, and, secondly in RCE Amendment A *timely filed on 7 July 2003 by telefax, resent to Supervisory Patent Examiner Kelly on 22 September 2003 by telefax but not noted by the Examiner of record as being filed until 12 December 2003 in the RCE Final Office Action dated 5 March 2004*. Attention is drawn to page 2 and the remarks in the second full paragraph on page 6 of RCE Amendment A filed on 07 July 2003 and to the clean set of amended claims on page 2, the marked up amended claims on page 5 and the remarks on page 6 of the Amendment After Final filed on 30 January 2003. Thus, it is clear that Appellants have made a bona fide attempt in the responses to all of the office actions to overcome the rejection by distinguishing between metallic foils (such as household aluminum foil) known to the Examiner and the paper decorative films/foils known by those skilled in the art and as used in the industry. As the terms “film” and “foil” are interchangeable within the industry of this invention but the Examiner held that the entire disclosure comprised a **metallic** material such as household aluminum foil, Appellants believed that the use of the word “paper” was necessitated to clearly distinguish between the metallic foils known to the Examiner and the wrapping material of this invention. Therefore, “paper” has been used in the instant claims for the decorative wrapping of this invention primarily to overcome the Examiner’s holding that the decorative wrapping material is metallic and to make clear to the general public that the

underlying substrate is a “paper.” Appellants therefore believe that not only are the claims clear under 35 U.S.C. 112 second paragraph, but that the claims also distinguish over recited references, including those of Abrams, Suess, et al., Salgado, et al., and Kotin as will be fully explained hereinafter.

The Official Action rejects claims 1 - 15, 17 - 18 and 20 under 35 U.S.C. 103(a) as being unpatentable over Kotin, U. S. Patent 5,996,672 in view of Salgado, et al., U. S. patent 6,361,839 B1. Specifically, the Examiner states that Kotin discloses a decorative film having an **embossed** paper substrate that is **easy to print** with an **adhesive** applied to the back of the film. 35 U.S.C. 103(a) states: “A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.” It is clear to those who practice and skilled in the art that with regard to claim 1, Appellants **do not describe an embossed paper substrate**, reserving this for independent claim 11, **do not print on the paper film**, as a printed decorative layer already exists on the paper film, and **only claim the adhesive opposite the married foils** in dependent claim 4. The Examiner is rejecting the entire set of claims on restrictions which appear in only selected claims and with words and/or methods which do not appear in the claims at all. Such was also the case in the original specification wherein the term “metallic” appeared in only two dependent claims, yet was used to reject the entire set. Thus, the claims are, and were in previous actions, in violation of the last sentence of 35USC.103(a), being negated with respect to the manner in which the invention was made. Furthermore, the rejection spans several claims without specific rejection to any one claim, and thus, this paragraph and the next four are specific to claim 1.

The description in Kotin relied upon by the Examiner appears in column 6 beginning at line 44 wherein Kotin recites that the substrate is one of four different types including an embossed substrate and may include other films such as polypropylene and



polyethylene, vinyl and various laminates of paper and film. Appellants have admitted that these substrates are commonly used in the art and, in fact, Appellants begin with the very materials Kotin cites, however, Appellants thereafter **apply at least one finishing layer** onto the decorated side of the commercially available substrate by laminating at least one hot stamping foil thereto thus **making the finishing layer an integral part** of the original commercially available material, the finishing layer changing the appearance of the original commercially available material. In fact, Appellants start with **any** of the previously prepared film materials cited in Kotin or Salgado, et al., as well as those already commercially available and thereafter marry a different hot foil stamping to the decorated side of the previously prepared film to change the appearance of the previously prepared film. It is abundantly clear to those skilled in the art that Kotin merely laminates a commercially available decorative film to a wood slat using a Polyurethane Reactive hot melt adhesive, a process well known in the art and disclosed by Appellants in the prior art statement. It is also abundantly clear to those skilled in the art that Salgado, et al., merely claim a hot stamping foil having thermochromic properties that is carried on a carrier which displays a **thermochromic effect without chemical reaction with another compound** and thus claim only a **single layer** of thermochromic hot stamping foil disposed on a carrier, wherein the thermochromic layer changes color dependent upon temperature. Therefore, Salgado, et al., bring only a thermochromic hot stamping foil to the industry and do not teach, suggest, claim, discuss or show a wrapping film having **more than one layer** of decorative material on the decorative side. In sharp contrast, the gist of Appellants' invention in claim 1 lies in the decorative wrapping film comprising a planar paper which already has a decorative coating previously disposed on one surface of the planar paper and wherein at least one more decorative coating is subsequently disposed upon the already existing decorative coating, the one decorative coating comprising a hot transfer foil married to the planar wrapping paper thus creating the decorative wrapping film. As stated above, those skilled in the art clearly recognize that Kotin merely wraps the fan blade substrate with a **single** decorative layer of known material and Kotin in view of Salgado, et al., would merely substitute that **single** decorative layer of known material with a **single**

decorative layer of the temperature dependent thermochromic layer of Salgado, et al. Therefore, it is not obvious to those skilled in the art to hot transfer at least one hot transfer foil to an already decorated surface of a wrapping film and thus provide a joinder of two or more decorative coatings wherein the first is either applied to a carrier or already exists thereupon and at least one more hot stamping foil is applied to the first coating to provide a laminated coating on one wrapping film wherein the carrier is stripped from each of the hot stamping foils applied to the carrier and thereafter the prepared wrapping film is rolled on a roll for subsequent use. (Emphasis added)

The Examiner also states that Kotin discloses a decorative film that is **laminated** and that a substrate may be wrapped with a printed film where the film is flexible and can be a foil wrap. However, a close inspection of Kotin in column 8 in lines 15 - 21, reveals that the **adhesive** is used to **lamine** the decorative film to the core, a process well known in the art and cited by Appellants as known in the prior art statement on page 2 in lines 22 - 25, but Kotin does not laminate the decoration to the paper or another decorated coating, as implied by the Examiner. At the place of this citation, Kotin only discusses **laminating an adhesive** layer in the statement “(A) variation of this may be to use a thermoplastic film with good moisture barrier properties to the decorative film and heated to its melt point prior to application to the core so it adheres to the core(.)” therefore merely substituting the polyurethane adhesive applied by the glue gun with a thermoplastic adhesive film, this thermoplastic adhesive film applied to the side opposite the decoration on the decorative film. If, as the Examiner uses to reject Appellants claims, that the thermoplastic adhesive film were laminated to the decorative surface, the decorative surface would then be applied toward the core thus defeating of the purpose of providing a decorative wrapping film for the core. As recited above, it is clear to those who practice and are skilled in the art that Kotin merely covers a wooden slat for a window covering in the same manner as has been well known in the industry, Kotin now bringing a polyurethane reactive adhesive to the art to create a moisture impervious barrier that prevents the core from laminating or warping. Thus, the importance of Kotin lies in the moisture impervious barrier **adhesive** not in the decorative wrapping foil itself or in improvements thereto as recited in Appellants’

disclosure. Regarding the Examiner's assertion that the substrate may be wrapped with a flexible film, by its nature, a decorative wrapping film is flexible, most likely is a printed paper or vinyl film and is used to wrap a substrate as Appellants have fully disclosed in the prior art statement on pages 2 - 4. Therefore, those practiced in the art recognize that hot transferring of at least one hot transfer foil to an already decorated surface is not known in the art and would be a welcome addition thereto. (Emphasis added)

The Examiner further states that Salgado, et al., teach a **hot stamping foil** comprising a carrier where the carrier of the hot stamping foil is removable and/or the hot stamping foil may be applied to wood or paper. Appellants have fully disclosed the removable nature of the carrier as removal of the carrier is common in the art. Attention is respectfully drawn to Appellants' prior art statement on page 2 in lines 12 - 16, again in lines 17 - 21. Those skilled in the art are fully aware of the stripping of the carrier from a hot stamping foil but are not aware of the hot transfer ink applied to an already decorated surface of a wrapping foil. Appellants believe that all the claims have been negated based upon selection of single words from certain of the claims and thus the rejections are in violation of the last sentence of 35USC.103(a). (Emphasis added)

Additionally, Kotin does also discuss an overcoat 56 which may be applied over the printed film substrate which is preferably clear and provides toughness to the surface of the film so that the printed pattern 54 cannot easily be scratched or marred. It must be noted, however, that the overcoat is a polyurethane emulsion dispersed in a solvent and thus would need to be applied by **dipping, painting or spraying** onto the decorative coating and would not be applied as a hot stamping foil as claimed by Appellants. Attention is drawn to column 7 of Kotin beginning at the end of line 1 continuing into line 8. Thus, it should be clear that the only application over the printed surface recited by Kotin is a protective coating and does not function to change the appearance of the underlying decorative layer whereas Appellants apply at least one hot stamping foil onto the underlying decorative layer to change the appearance thereof. Again the claims are being negated by the manner in which the invention is made clearly in violation of the last sentence of 35USC.103(a). In view of the above arguments, Appellants respectfully appeal

for reconsideration and allowance of claim 1. (Emphasis added)

With regard to claims 1 and 4, Appellants are limiting the scope of claim 1 with the application of the adhesive to the side opposite the newly applied hot transfer foil, thus limiting the scope of a previous claim fully within the scope of the statutes as found in 35 U.S.C. 112, fourth paragraph which states “(c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application.” Where the Examiner apparently notes that Kotin applies a second coating film, in column 8, lines 17 - 20 of Kotin, the careful reading referred to in the argument above with regard to claim 1 reveals that the coating referred to by the Examiner is instead an **adhesive** which must be applied to the underside of the substrate carrying the decorative film as is conventional and not to the decoration side as implied by the Examiner, else the decorative side would be adhered to the core thus defeating the purpose of decorating the surface in the first place. Thus, Appellants are limiting the scope of claim 1 wherein a previously prepared decorative coating already exists on a wrapping substrate to which Appellants apply at least one other hot stamping foil to the decorative surface and thereafter apply the adhesive to the side opposite the decoration, the limiting of the scope of the claim fully provided for in the statutes as noted above. Appellants have admitted the practice of applying an adhesive to the reverse side of a commercially available thermoplastic or paper sheet (foil, film) having a thin coat of ink or paint on one side, i.e. Salgado, et al., or the decorative film materials and substrates cited in column 6 of Kotin, such structure defining a commercially available decorative wrapping film. For reference, attention is respectfully drawn to lines 22 - 25 on page 2 of Appellants’ Original disclosure filed on 23 October 2000. Appellants are not reinventing application of the adhesive to a single layer foil paper wrapping film but rather limiting the scope of broader claim 1 with the application of the adhesive layer to the novel film having now at least two layers of decoration applied thereto. Therefore, Appellants respectfully appeal for reconsideration and allowance of claim 4 with claim 1.

In claim 5, Appellants limit the scope of claim 1 to include a translucent hot transfer foil. In the rejection appealed, the Examiner states Salgado, et al., further teaches

that the foil material may be colorless or a variety of colors depending on the temperature and therefore “(I)t would have been obvious to one of ordinary skill in the art to include a colorless (translucent) or colored (opaque) hot stamping foil on the laminated decorative film of Kotin because Salgado, et al., teaches the conventionality of applying a hot stamping foil to substrates such as wood or paper which Kotin comprises, which improves the transfer of ink images onto a substrate.” Appellants respectfully appeal the rejection advanced by the Examiner as follows. Translucent is defined in Webster’s New Twentieth Century Dictionary, Unabridged Second Edition, as “letting light pass but diffusing it so that objects on the other side cannot be distinguished.” Though translucent material may be colorless, it is not always so. For instance, Webster’s gives “frosted glass” as an example of translucent material which would be not necessarily be colored. In this claim 5, it is Appellants’ intent to apply a translucent hot stamping foil to a previously prepared decorative film to **obscure** but **not obliterate** the underlying preparation. Salgado, et al., only teach a thermochromic hot stamping film and do not suggest, teach, show or otherwise discuss that at least one hot stamping foil is applied to the previously decorated film and further do not teach that the thermochromic hot stamping foil is translucent though it should be readily apparent that Appellants could apply at least one other translucent hot stamping foil to the already decorated surface of Salgado, et al., thus improving the art field to include a decorative wrapping film having a previously laid thermochromic hot stamping foil and thereafter having at least one other translucent hot stamping foil applied to the thermochromic layer obscuring the thermochromic layer. In claim 5, Appellants are again merely limiting the scope of the independent claim 1 as fully provided for in the statutes in 35 U.S.C. 112, fourth paragraph and respectfully appeal for reconsideration and allowance of claims 1 and 5. (Emphasis added)

With regard to claim 6, Appellants are again limiting the scope of claim 1 to include an opaque hot transfer foil applied to a previously prepared decorative wrapping film. The Examiner has stated that “(I)t would have been obvious to one of ordinary skill in the art to include a colorless (translucent) or colored (opaque) hot stamping foil on the laminated decorative film of Kotin because Salgado, et al., teaches the conventionality of

applying a hot stamping foil to substrates such as wood or paper which Kotin comprises, which improves the transfer of ink images onto a substrate.” Appellants respectfully appeal the rejection of claim 6 as follows. Opaque is defined in Webster’s New Twentieth Century Dictionary, Unabridged Second Edition, as “not letting light pass through; not transparent; as, chalk is an opaque substance.” Though opaque material may be colored, it is not always so as evidenced by the example given in Webster’s. Kotin teaches only application of the decorative film to a wood slat for a window covering, the decorative film being one of the multitude of available decorative wrapping films Kotin recites in column 6 beginning in line 44. Kotin further provides for a **clear** overcoat 56 as described therein beginning in line 1 of column 7 continuing through to line 10, and thus would teach away from an **opaque** material. Furthermore, it is noted that Kotin teaches, in the above cited reference, that the overcoat is a polyurethane emulsion dispersed in a solvent and therefore is **not** a hot stamping foil as implied by the Examiner. As Appellants are applying an opaque hot transfer coating to a previously prepared wrapping film, it is evident that an advancement in the art has been described and Appellants respectfully appeal for reconsideration and allowance of claims 1 and 6. (Emphasis added)

Claim 2 adds onto claim 1 yet another layer of hot transfer foil thereby providing at least three layers of decorative material upon the surface of the paper wrapping film. As fully described above, Kotin merely applies a conventional hot stamped wrapping film to a wood slat but does not provide an additional hot stamping foil upon the previous decorative surface of the conventional hot stamped wrapping film, and therefore Kotin could not also apply yet another layer of hot transfer foil. Salgado, et al., teaches a thermochromic wrapping film having a single thermochromic layer and does not teach at least one additional hot stamping foil applied to the thermochromic layer as provided in claim 1 and further could not therefore teach applying yet another hot stamping foil upon a the additional hot stamping foil as provided by Appellants. Therefore, it is clear that Appellants have improved upon the art in claim 2 by providing a decorative wrapping film having a previously prepared decorative surface, applying at least **one** hot stamping foil upon the previously prepared decorative surface as recited in claim 1 and thereafter

applying yet at least **one other** hot stamping foil upon the first hot stamping foil already laid upon the previously prepared decorative surface thus making at least three decorative coatings upon the wrapping fail. Appellants, thus respectfully appeal for reconsideration and allowance of claims 1 and claim 2. (Emphasis added)

In claim 3, where the other coating foil is applied to the hot foil stamping applied to the previously decorated wrapping film by the method in apparatus of this invention, Appellants are again limiting the scope of claims 2 and 1 together by applying an adhesive to the underside of the wrapping film and not to decorative surface as would have to be the case if applying the Examiner's understanding of the teachings of Kotin alluded to in the rejection. As Appellants have admitted the practice of applying an adhesive to the reverse side of a commercially available wrapping film, limiting the scope of claims 2 and 1 as provided in claim 3 is fully within the statutes in the fourth paragraph of 35 U.S.C. 112. Accordingly, Appellants respectfully appeal for reconsideration and allowance of claims 1, 2 and 3.

It has already been set forth that "opaque" does not allow light to pass through an object and thus limiting of claims 1 and 2 as provided in claim 7 is within the statutes in the same manner as claim 6 limits claim 1 provided above. The wrapping film in claim 7 comprises a previously prepared decorative wrapping film having one opaque hot stamping foil applied to the decorative surface of the previously prepared wrapping film and thereafter has at least one other hot stamping foil applied to the opaque hot stamping foil. As neither Salgado, et al., nor Kotin teach applying one layer to the previously prepared decorative layer by hot stamping, neither could also teach that one layer would be opaque nor would it be obvious to one skilled in the art by reading Salgado, et al., in view of Kotin to make the one layer opaque and thereafter apply at least one other hot transfer foil. Therefore, Appellants respectfully appeal for reconsideration and allowance of claims 1, 2 and 7.

Likewise, as neither Salgado, et al., nor Kotin teach applying either one hot stamping foil to a previously decorated surface as recited above, nor another layer to the one layer as Appellants have provided in this specification in claims 1 and 2, Kotin in view

of Salgado, et al., does not also teach Appellants disclosure. As Kotin in view of Salgado, et al., does not teach one hot stamping foil applied to a previously decorated surface that is opaque, Kotin in view of Salgado, et al., does not also teach another layer which is translucent applied to the first opaque layer as claimed by Appellants in claim 8. Thus, Appellants also respectfully appeal for reconsideration and allowance of claims 1, 2, 7 and 8.

Since it has already been set forth that “translucent” allows light to pass through but diffuses the light so that objects on the other side may not be readily distinguished, limiting of claims 1 and 2 as provided in claim 9 is within the statutes in the same manner as claim 5 limits claim 1 provided above. The wrapping film in claim 9 would thus comprise a previously prepared decorative wrapping film having a first translucent hot stamping foil applied to the decorative surface of the wrapping film and thereafter having at least one other hot stamping foil applied to the translucent hot stamping foil. As neither Salgado, et al., nor Kotin teach applying a second layer to the first decorative layer by hot stamping, it is readily apparent to those skilled in the art that neither reference nor a combination thereof could also teach that a second layer would be translucent. Therefore, Appellants respectfully appeal for reconsideration and allowance of claims 1, 2 and 9.

Since neither Salgado, et al., nor Kotin teach applying either a hot stamping foil to a previously decorated surface as recited above, nor another layer to the one layer as Appellants have provided in this specification in claims 1 and 2, Kotin in view of Salgado, et al., does not also teach Appellants disclosure. As Kotin in view of Salgado, et al., does not teach a hot stamping foil applied to a previously decorated surface that is translucent, Kotin in view of Salgado, et al., does not also teach another layer which is also translucent applied to the first translucent layer as claim to by Appellants in claim 10. Thus, Appellants also respectfully appeal for reconsideration and allowance of claims 1, 2, 9 and 10.

Claim 11 of Appellants’ disclosure introduces an already prepared, commercially available **embossed** wrapping film, such as recited in Kotin and improves upon the commercially available embossed wrapping foil by **applying at least one finishing layer** onto the printed side of the commercially available, embossed film by laminating at least



one hot stamping foil thereto thus **making the finishing layer an integral part** of the original commercially available embossed wrapping film, the finishing layer changing the appearance of the original commercially available embossed wrapping film. The description in Kotin relied upon by the Examiner appears in column 6 beginning at line 44 wherein Kotin recites that the substrate is one of four different types including an embossed substrate and may include other films such as polypropylene and polyethylene, vinyl and various laminates of paper and film. As previously set forth, Appellants have fully admitted the commercially available **embossed** wrapping film which may be made of any of the materials disclosed in Kotin and therefore, the commercially available embossed wrapping film is not the subject of Appellants disclosure and claims. As set forth above, Kotin provides only a commercially available wrapping film which may be embossed either before or after the printing step as Kotin describes in lines 61 through 63 in column 6, however, it is abundantly clear that Kotin merely laminates the commercially available embossed decorative film to a wood slat using a Polyurethane Reactive hot melt adhesive, a process well known in the art and disclosed by Appellants in the prior art statement. Attention is again respectfully called to page 2 of the original disclosure in lines 22 through 25. It is also abundantly clear that Salgado, et al., bring only a thermochromic layered hot stamping foil, which changes its color dependent upon temperature to the industry and do not teach, suggest, claim, discuss or show an embossed wrapping film having at least two different layers of decorative material on the decorative side. In claim 11, Appellants' invention brings forth an improvement to commercially available **embossed** decorative film which has a first decorative coating previously disposed on one surface of the embossed paper, wherein according to the teachings of this invention at least one additional decorative coating is subsequently disposed upon the first decorative coating, the one decorative coating comprising a hot transfer foil married to the embossed wrapping paper thus creating the embossed decorative wrapping film. As Kotin merely wraps the fan blade substrate with a layer of commercially available embossed material having a **single** decoration one surface thereof, it is only obvious to those skilled in the art that Kotin in view of Salgado, et al., would merely substitute that **single** decoration of the commercially

available embossed material with a **single** decoration of a temperature dependent thermochromic material of Salgado, et al., wherein the wrapping film still only comprises a single decoration of one surface thereof. Additionally, as set forth above with regard to claim 1, the Examiner also states that Kotin discloses a decorative film that is **laminated** and that a substrate may be wrapped with a printed film where the film is flexible and can be a foil wrap. However, as discussed above, a close inspection of Kotin in column 8 in lines 15 - 21, reveals that the **adhesive** is used to **lamine the decorative film to the core**, a process well known and practiced by those in the art and cited by Appellants in the prior art statement on page 2 in lines 22 - 25, but Kotin does not laminate the decoration to the embossed film or to another decorated coating, as claimed by Appellants. In column 8 in lines 15 - 21, Kotin only discusses **laminating an adhesive** layer in the statement therefore merely substituting the polyurethane adhesive applied by the glue gun with a thermoplastic adhesive film, this thermoplastic adhesive film applied to the side opposite the decoration on the decorative film. As recited above, it is clear that Kotin merely covers a wooden slat for a window covering in the same manner as has been well known in the industry, Kotin now bringing a polyurethane reactive adhesive to the art to create a moisture impervious barrier that prevents the core from laminating or warping. Thus, the importance of Kotin lies in the moisture impervious barrier **adhesive** not in the decorative embossed wrapping foil itself not in the improvements thereto as recited in Appellants' disclosure. Also was discussed above, a decorative wrapping film is naturally flexible, most likely is a printed film, in this case is also an embossed film and is used to wrap a substrate as Appellants have fully disclosed in the prior art statement on pages 2 - 4. (Emphasis added)

The Examiner further states that Salgado, et al., teach a **hot stamping foil** comprising a carrier where the carrier of the hot stamping foil is removable and/or the hot stamping foil may be applied to wood or paper. Appellants have fully disclosed the removable nature of the carrier as removal of the carrier is common in the art. Attention is respectfully drawn to Appellants' prior art statement on page 2 in lines 12 - 16, again in lines 17 - 21. (Emphasis added)

Additionally, the overcoat 56 which may be applied over the printed film in Kotin is preferably clear and provides toughness to the surface of the film so that the printed pattern 54 cannot easily be scratched or marred. The overcoat is a polyurethane emulsion dispersed in a solvent and thus would need to be applied by dipping, painting or spraying onto the decorative coating and would not be applied as a hot stamping foil as claimed by Appellants. Attention is drawn to column 7 of Kotin beginning at the end of line 1 continuing into line 8. Thus, it should be clear to those in the art that the only application over the printed surface recited by Kotin is a clear protective coating and does not function to change the appearance of the underlying decorative layer whereas Appellants apply at least one hot stamping foil onto the underlying embossed decorative layer to change the appearance thereof. In view of the above arguments, Appellants respectfully appeal for reconsideration and allowance of claim 11.

Neither Salgado, et al., nor Kotin apply one hot stamping foil to a previously prepared decorative surface of an **embossed** decorative wrapping film and therefore neither could also apply yet at least one other hot stamping foil to the previously laid hot stamping foil longer previously prepared decorative surface of the embossed decorative wrapping film as claimed by Appellants in claim 12. It should be readily evident that the improvements in the art of supplying embossed, decorative wrapping films having one hot stamping foil applied to the embossed surface and thereafter having at least one other hot stamping foil applied to the one hot stamping foil have not been described in the prior art references cited by the Examiner nor would be evident by reading Kotin in view of Salgado, et al. Accordingly, Appellants respectfully appeal for reconsideration and allowance of claim 12 along with claim 11. (Emphasis added)

In claim 13, Appellants are again limiting the scope of claims 12 and 11 together by applying an adhesive to the underside of the wrapping film and not to decorative surface as would have to be the case if applying the Examiner's understanding of the teachings of Kotin alluded to in the rejection. As the fourth paragraph of 35 U.S.C. 112 provides for limiting of the broader claim referred to in the dependent claim, limiting the scope of claims 11 through claim 12 as provided in claim 13 is fully within the statute. Accordingly,

Appellants respectfully appeal for reconsideration and allowance of claims 11, 12 and 13.

Claim 11 may also be further limited by claimed 14, as provided for in the fourth paragraph of 35 U.S.C. 112, by applying an adhesive to the side opposite the hot stamping foil now applied to the **embossed** surface of the commercially available embossed decorative wrapping film. Thus, the adhesive is applied, not to decorative surface as would be the case in following the suggestion of the Examiner, but to the side opposite the decorative surfaces as would be required in order to subsequently wrap the newly created embossed decorative wrapping film to a substrate, including the wooden slat for a window covering claimed in Kotin. Since claim 14 merely limits claim 11 by providing an adhesive opposite the one hot stamping foil applied to the previously decorative surface of the wrapping film, Appellants respectfully appeal for reconsideration and allowance of claims 11 and 14. (Emphasis added)

Claim 15 limits independent claim 11 in the same way claim 6 limits claim 1 as set forth above and thus Appellants are limiting the scope of claim 11 to include an opaque hot transfer foil applied to a previously prepared embossed decorative wrapping film. As noted above, opaque is defined in Webster's New Twentieth Century Dictionary, Unabridged Second Edition, as "not letting light pass through; not transparent; as, chalk is an opaque substance." Though opaque material may be colored and, indeed, many chalks are colored, however, the traditional chalk is white, which is the reflection of all color and therefore can not also be colored. Kotin discusses only commercially available decorative wrapping films as Kotin recites in column 6 beginning in line 44. Furthermore, the **clear** overcoat 56 as described in line 1 of column 7 continuing through to line 10 of Kotin, it would appear that Kotin teaches away from an **opaque** material. Finally, it is noted that Kotin teaches, in the above cited reference, that the overcoat is a polyurethane emulsion dispersed in a solvent and therefore is **not** a hot stamping foil as implied by the Examiner. As Appellants are applying an opaque hot transfer coating to a previously prepared wrapping film, it is evident that an advancement in the art has been described by Appellants and Appellants therefore respectfully appeal for reconsideration and allowance of claims 11 and 15. (Emphasis added)

As with claim 5, Appellants limit the scope of claim 11 in claim 17 to comprise a translucent hot transfer foil that is applied to a previously prepared embossed decorative wrapping film. In the rejection appealed, the Examiner states Salgado, et al., teaches that the foil material may be colorless or a variety of colors depending on the temperature and therefore “(I)t would have been obvious to one of ordinary skill in the art to include a colorless (translucent) or colored (opaque) hot stamping foil on the laminated decorative film of Kotin because Salgado, et al., teaches the conventionality of applying a hot stamping foil to substrates such as wood or paper which Kotin comprises, which improves the transfer of ink images onto a substrate.” Appellants respectfully appeal the rejection advanced by the Examiner because as set forth above, translucent is defined as “letting light pass but diffusing it so that objects on the other side cannot be distinguished.” Though translucent material may be colorless, it is not always so. For instance, Webster’s gives “frosted glass” as an example of translucent material which may be not be colored, and in fact, the traditional frosted glass appears white and thus would reflect all color and could not also appear to be “colored”. As with claim 5, in claim 17 it is Appellants’ intent to apply a translucent hot stamping foil to a previously prepared embossed decorative film to **change the appearance of** the underlying embossed decorative film. Salgado, et al., only teach a single decoration comprising a thermochromic hot stamping film and do not suggest, teach, show or otherwise discuss that at least one hot stamping foil is applied to the previously decorated embossed film and further do not teach that the thermochromic hot stamping foil is translucent though it should be readily apparent that Appellants could apply at least one other translucent hot stamping foil to the already decorated surface of Salgado, et al., thus improving the art field to include a decorative wrapping film having a previously laid thermochromic hot stamping foil and thereafter having at least one other translucent hot stamping foil applied to the thermochromic layer obscuring the thermochromic layer. Appellants, in claim 17, are merely limiting the scope of the independent claim 1 as fully provided for in the statutes in 35 U.S.C. 112, fourth paragraph and therefore Appellants respectfully appeal for reconsideration and allowance of claims 11 and 17. (Emphasis added)

In the same manner that claim 6 provides an opaque hot transfer foil that is applied to a planar paper, claim 18 applies an opaque hot transfer foil to a previously prepared embossed decorative film to change the appearance thereof. With regard to claim 18, Appellants are limiting the scope of claim 11 to comprise an opaque hot transfer foil applied to a previously prepared embossed decorative wrapping film. Opaque is defined in Webster's New Twentieth Century Dictionary, Unabridged Second Edition, as "not letting light pass through; not transparent; as, chalk is an opaque substance," and it is evident from a careful reading of Appellants' disclosure and claims that Appellants fully intend to change the appearance of the exterior surface of the previously prepared embossed decorative wrapping foil by applying an opaque coating thereto by a hot transfer foil. Neither Kotin nor Salgado, et al., change the appearance of the previously prepared embossed decorative wrapping film has only Kotin describes applying an overcoat thereto, however Kotin provides for a **clear** overcoat 56 as described in line 1 of column 7 continuing through to line 10, and thus would teach away from an **opaque** material. Furthermore, it is noted that Kotin teaches, in the above cited reference, that the overcoat is a polyurethane emulsion dispersed in a solvent and therefore is **not** a hot stamping foil as implied by the Examiner. As Appellants are applying an opaque hot transfer coating to a previously prepared embossed wrapping film, it is evident that an advancement in the art has been described and Appellants respectfully appeal for reconsideration and allowance of claims 11 and 18. (Emphasis added)

Claim 20 is completely foreign to either the disclosure of Kotin or that of Salgado, et al., in that neither reference shows removal of any portion of a second coating and in fact only Kotin shows an overcoat applied to the decorative surface and that overcoat is applied as an immersion not a transfer film and therefore it must cover entire surface or else it would defeat stated purpose of water imperviousness. Therefore, even this overcoat cannot be removed from the decorative surface to expose the underlying decorative surface as it would also expose the underlying decoration to intrusion of moisture. Furthermore, since the overcoat is applied as an immersion, the surface facing the underlying decoration could not be physically removed as recited in claim 20 of Appellants disclosure, as the surface facing the underlying decoration in the patent to Kotin is liquid when applied and as such could not have a portion removed therefrom prior to application, and after application, this surface would be inaccessible. Therefore, is obvious only that none of the prior art, and especially the prior art cited by the Examiner, shows a decorative wrapping film comprising at least one hot transfer ink foil carried on a carrier wherein a portion of the ink thereon is removed

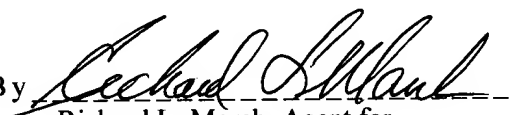
prior to laminating the remainder upon a previously decorated wrapping film, the portion of the hot transfer ink foil removed exposing a like portion of the underlying base decoration of the wrapping film. Even a combination of Kotin in view of Salgado, et al., or vice versa, does not disclose removal of any portion of the hot transfer foil prior to application to a previously decorated wrapping film. As it is clear to those in the art that Kotin in view of Salgado, et al., does not describe, could not anticipate and will not reveal the matter contained within claim 20 of Appellants disclosure, Appellants hereby respectfully appeal for reconsideration and allowance of claim 20.

Thus, it should be abundantly clear that Appellants have shown that none of the prior art, including the instant references of Kotin and Salgado, et al., alone or Kotin in view of Salgado, et al., or Salgado, et al., in view of Kotin show, describe, suggest or claim a previously prepared wrapping film having at least one hot transfer inked foil laminated thereonto as claimed in Appellants' specification whether the previously prepared wrapping film is a planar wrapping film or an embossed wrapping film. Furthermore, as claimed in claim 20, it should also be evident that none of the prior art describes removing a portion of the hot transfer ink prior to applying the hot transfer foil to either a planar or embossed wrapping film.

In view of the foregoing discussion, Appellants respectfully request that the Honorable Board of the Patent Appeals and Interferences overrule the final rejection of claims 1 through 15, 17 - 18 and 20 over all of the cited prior art, and hold that Appellants' claims be allowable over such art.

Respectfully submitted,

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## Appendix

1. A paper decorative wrapping film comprising at least one hot transfer inked foil carried on a carrier having said at least one said hot transfer inked foil laminated onto a planar wrapping paper thereby marrying said at least one hot transfer foil to said planar wrapping paper, said marrying creating said paper decorative wrapping film wherein said carrier is removed from said paper decorative wrapping film and said paper decorative wrapping film is wound upon a roll for use in wrapping of a substrate.

2. A paper decorative wrapping film as in claim 1 wherein said paper decorative wrapping film has at least one other hot transfer foil layered onto said paper decorative wrapping film thereby marrying said at least one other hot transfer foil to said planar wrapping paper, said marrying creating said paper decorative wrapping film wherein said carrier is removed from said paper decorative wrapping film and said paper decorative wrapping film is wound upon a roll for use in wrapping of a substrate.

3. A paper decorative wrapping film as in claim 2 wherein said paper decorative wrapping film has an adhesive applied to a side of said paper decorative wrapping film opposite said one other hot transfer foil, said paper decorative wrapping film wrapped about a substrate to be decorated.

4. A paper decorative wrapping film as in claim 1 wherein said paper decorative wrapping film has an adhesive applied to a side of said paper decorative wrapping film opposite said hot transfer foil, said paper decorative wrapping film wrapped about a substrate to be decorated.

5. A paper decorative wrapping film as in claim 1 wherein said at least one said hot transfer inked foil is a translucent hot transfer foil.

6. A paper decorative wrapping film as in claim 1 wherein said at least one said hot transfer inked foil is an opaque hot transfer foil.

7. A paper decorative wrapping film as in claim 2 wherein said at least one said hot transfer inked foil is an opaque hot transfer foil.

8. A paper decorative wrapping film as in claim 7 wherein said at least one said other said hot transfer inked foil is a translucent hot transfer foil.



9. A paper decorative wrapping film as in claim 2 wherein said at least one said hot transfer inked foil is a translucent hot transfer foil.

10. A paper decorative wrapping film as in claim 9 wherein said at least one said other said hot transfer inked foil is a translucent hot transfer foil.

11. A paper decorative wrapping film comprising at least one hot transfer inked foil carried on a carrier, said at least one said hot transfer inked foil laminated onto an embossed wrapping paper thereby marrying said at least one hot transfer foil to said embossed wrapping paper, said marrying creating a laminated embossed wrapping paper wherein said carrier is removed from said laminated embossed wrapping paper and said embossed laminated wrapping paper is wound upon a roll for use in wrapping of a substrate.

12. A paper decorative film as in claim 11 wherein said embossed laminated wrapping paper has at least one other hot transfer foil layered onto said embossed layered paper thereby marrying said at least one hot transfer foil to said planar wrapping paper, said marrying creating a laminated embossed wrapping paper wherein said carrier is removed from said laminated embossed wrapping paper and said laminated embossed wrapping paper is wound upon a roll for use in wrapping of a substrate.

13. A paper decorative film as in claim 12 wherein said laminated embossed wrapping paper has an adhesive applied to a side of said laminated embossed wrapping paper opposite said one other hot transfer foil, said laminated embossed wrapping paper wrapped about a substrate to be decorated.

14. A paper decorative film as in claim 11 wherein said laminated embossed wrapping paper has an adhesive applied to a side of said laminated wrapping paper opposite said hot transfer foil, said laminated embossed wrapping paper wrapped about a substrate to be decorated.

15. A paper decorative film as in claim 11 wherein said at least one said hot transfer inked foil is an opaque hot transfer foil.

~~{16. (canceled) A decorative molding film as in claim 11 wherein said at least one said hot transfer inked foil is a metallic hot transfer foil.}~~

17. A paper decorative film as in claim 11 wherein said at least one said hot transfer inked foil is a translucent hot transfer foil.

18. A paper decorative film as in claim 12 wherein said at least one said hot transfer inked foil is an opaque colored hot transfer foil.

~~{19. (canceled) A decorative molding film as in claim 12 wherein said at least one said other hot transfer inked foil is a metallic hot transfer foil.}~~

20. A paper decorative wrapping film comprising at least one hot transfer inked foil carried on a carrier, said at least one said hot transfer inked foil having a portion of the ink thereon removed prior to being laminated onto a planar paper wrapping film thereby creating a laminated paper wrapping film having portions of the base color of said planar paper wrapping film showing therethrough wherein said carrier is removed from said laminated paper wrapping film and said laminated paper wrapping film is wound upon a roll for use in wrapping of a substrate.